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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,651	04/16/2001	Takeshi Fukuda	05453.0037	3687

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FINNEGAN, HENDERSON, FARABOW, GARRETT &
DUNNER LLP
1300 I STREET, NW
WASHINGTON, DC 20006

EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/834,651

Applicant(s)

FUKUDA ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claims 1-10 are pending. Claims 4-5 are withdrawn from consideration, as they are directed to non-elected subject matter. The Amendment filed 12/16/02, Paper No. 7, amended claims 1-3, 6-10, and the title.

Response to Applicant's Arguments/Amendment

The Applicant's arguments filed 12/16/02 (Paper No. 7) to the rejection of claims 1-3, 6-10 made by the Examiner under 35 USC 103 have been fully considered and deemed not persuasive.

The Applicant's arguments and amendments to the claims are sufficient to overcome the 35 USC 112 rejection in the previous Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase "produced using a source material that will introduce phosphate ions" is new and not part of the original disclosure.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) The phrase "produced using a source material that will introduce phosphate ions" in claim 1 (lines 3-4) is vague and indefinite, as it is not clear what a source material is. The specification does not define a source material and one of ordinary skill in the art would not be apprised of its meaning.

(ii) The phrase "the weight of said compound used in the calculation is the weight of P2O5" in claim 2 is vague and indefinite, as it is confusing. What does this mean and why is there a reference to P2O5?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibasaki et al. (5,587,010).

Shibasaki et al. teach a process for producing fine flaky alumina particles and alumina-based plastic material. It is disclosed that the particles can be combined with an organic water holding material and water. The particles are disclosed as having a size of 1um or less, a thickness of 0.1um or less, and a diameter ranging from 0.5-3.5um. The alumina particles are disclosed as comprising 63-67% of a composition comprising water and polyethylene glycol.

The reference lacks an exemplification of major diameter, thin flat form. See Col. 2, line 52-Col. 4, line 20; Col. 5, lines 9-11; Col. 6, lines 1-38.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to exemplify the flaky alumina particle of Shibasaki et al. as a) having a major diameter of 0.5-3.5 μ m, because Shibasaki et al. teach that depending on the hydrothermal synthesis process, the size of the particles can range from 0.5-3.5 μ m; and as b) having a thin and flat form, because Shibasaki et al. teach the particles as having a thickness of 0.1 μ m, which is thin, and as having a hexagonal form, which is flat.

Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibasaki et al. as applied to claims 1, 6-10 above, and further in view of Fukuda et al. (6,197,277).

Shibasaki et al. is applied as discussed above. The reference lacks P2O5 and zeta-potential.

Fukuda et al. teach alumina particles having high dispersibility and plasticity. The particles are disclosed as comprising 0.1-3% P2O5. It is disclosed that the isoelectric point at which the zeta-potential is 0 is of pH 4 to 8. See abstract; Col. 3, line 8-27; Col. 4, line 65-Col. 5, line 4.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the P2O5 of Fukuda et al. into the alumina particles of Shibasaki et al. because a) Fukuda et al. and Shibasaki et al. are both directed to flaky alumina particles for use in paints and ceramic molding, and; b) Fukuda et al. teach the addition of P2O5 to alumina particles as producing paints or ceramics with high dispersibility and plasticity.

Response to 103 Arguments

Applicant argues, “Shibasaki et al., on the other hand, discloses particles having a maximum average major diameter of no more than 3.5 μm ”. This argument is not persuasive. The Examiner respectfully points out that the instant independent claim recites an average major diameter of 0.5-25 μm , and that 3.5 μm falls within that range.

Applicant argues, “In addition, Shibasaki et al. neither teaches nor suggests the use of a source material that will introduce phosphate ions. . . Because Shibasaki et al. does not teach or suggest the use of phosphate ions as stated in amended claim 1, Applicants respectfully request that this rejection be withdrawn”. This argument is not persuasive. The Examiner respectfully points out that the instant claims are directed toward products and not methods of making particles, thus the limitation “produced using a source material that will introduce phosphate ions” recited in claim 1, is not afforded patentable weight. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966.

Applicant argues, “Shibasaki et al. neither teaches nor suggests the use of alumina particles in cosmetics”. This argument is not persuasive. The Examiner respectfully points out that Shibasaki et al. teach their particles for paint pigments, and a pigmented paint is a cosmetic.

Applicant argues, “the claimed cosmetic exhibits advantageous properties, including suitable gloss and luster, because of the use of alumina particles having the claimed

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characteristics. . .In addition, Example 5 reveals the unexpected results of the use of the claimed alumina particles in cosmetics, it would not have been obvious to one skilled in the art to use the claimed particles to achieve these advantageous properties in cosmetics". This argument is not persuasive. The Examiner, again, respectfully directs Applicant to MPEP 716.02, which discloses the guidelines for unexpected results. In the instant case, Example 5 is not commensurate in scope with the instant claims, and is not compared with the closest prior art. For these reasons alone, Example 5 is not persuasive to show unexpected results.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
January 22, 2003


SREENI PADMANABHAN
PRIMARY EXAMINER
1/25/03